

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

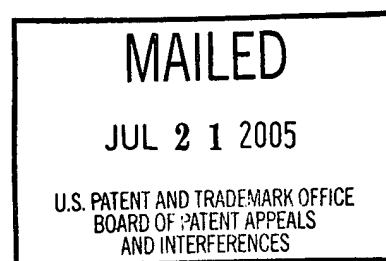
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAURI PIIKIVI and MARKKU HEISKALA

Appeal No. 2005-0032
Application No. 09/559,499

ON BRIEF



Before DIXON, BARRY, and MACDONALD, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3-7, 9-16, and 18-31, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

Appellants' invention relates to an advanced service redirector for a personal computer. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

1. A method for conducting electronic commerce, comprising steps of:

operating a computer to contact a commerce-related site using a browser;

automatically detecting a presence of a message received from the commerce-related site that requires, as a response, non-stored authentication information inputted by a user in response to the detected presence of the message;

in response to automatically detecting the presence of the message, sending a message from the computer to a mobile station over a bi-directional transmission link;

in response to receiving the message over the link, generating a user authentication message that is generated by prompting the user to enter a personal identification number (PIN) and comparing the entered PIN to a PIN stored in the mobile station;

passing the user authentication message from the mobile station to the computer over the bi-directional transmission link; and

sending user authentication information from the computer to the commerce-related site using the browser.

The prior art of record relied upon by the examiner in rejecting the appealed claims:

Wang	6,175,922	Jan. 16, 2001 (Filing date Mar. 13, 2000)
Donoho et al. (Donoho)	6,256,664	Jul. 3, 2001 (Filing date Mar. 19, 1999)

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Ladd et al. (Ladd)

6,269,336

Jul. 31, 2001
(Filing date Oct. 2, 1998)

Claims 23-25 and 28-31 stand rejected under 35 U.S.C. § 102 as being anticipated by Wang. Claims 1, 3-7, 9-16, and 18-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wang in view of Ladd. Claim 21 stands rejected under 35 U.S.C. § 103 as being unpatentable over Wang/Ladd in view of Donoho. Claims 26 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wang in view of Donoho. Claim 22 stands rejected under 35 U.S.C. § 103 as being unpatentable over Wang/Ladd in view of Donoho.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 17, mailed Dec. 2, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 16, filed Oct. 16, 2003) and reply brief (Paper No. 18, filed Feb. 4, 2004) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellants have elected to group the claims into three separate groupings with respect to three issues (A, B, C) as argued in the brief. (Brief at pages 4-6.) We address the claims in the same order that appellants address them. Only those arguments actually made by appellants have been considered in this

decision. Arguments that appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

ISSUE A

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against

employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) .

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1. Independent claim 1 states "in response to automatically detecting the presence of the message, sending a message from the computer to a mobile station over a bi-directional transmission link." Appellants then state the issue which questions whether any combination of the references teaches or

suggests a computer automatically sending a message to a mobile station in response to receiving a particular message from a commerce-related site or server? (Brief at pages 6-8.) The examiner maintains that the issue and the arguments thereto are not commensurate in scope with the language of independent claim 1. (Answer at page 12.) We agree with the examiner that the language of independent claim 1 does not expressly recite or impliedly claim that the message is “automatically” sent to the mobile station furthermore we do not find that the language of independent claim 1, “in response to” requires that the message be automatically sent in response to the step of automatically detecting the presence of a message. Appellants argue that the disposition of issue A turns on whether the above claim term implies automatic action. (Reply brief at page 3.) As discussed above, we do not find that the claim requires automatic action for this limitation. Therefore, this argument is not commensurate in scope and is not persuasive. Appellants argue and provide a definition that the limitation “in response to” provides a chronological relation between actions and has a cause and effect relation. (Reply brief at page 3.) While we agree with appellants that there is a chronological and causal relation, we do not agree with appellants that the causal relation is an “automatic” action. Appellants argue that an additional statement of “automatic” would be “repetitive and unnecessary.” (Reply brief at page 3.) We disagree in light of the examiner reasonable interpretation of the claim language, and we do not find appellants’ argument with respect to issue A to be persuasive and we find that the examiner has established a ***prima facie*** case of obviousness with respect to this issue.

ISSUE B

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. **See Studiengesellschaft Kohle v. Dart Indus., Inc.**, 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

Appellants argue that Wang does not disclose or anticipate a "list of certificates from which a user may select." (Brief at page 11.) The examiner maintains that appellants again do not identify and argue the specific language of the claims. (Answer at page 16.) We disagree with the examiner. We find appellants arguments sufficiently close to the language of the independent claims.

With respect to the list of certificates, the examiner maintains that appellants have not defined this term in the specification and the examiner "broadly interprets the certificates as documents containing information." (Answer at page 16.) The examiner

maintains that all the information that MAY BE used to authenticate corresponds to a list of certificates. (Answer at page 16.) We disagree with the examiner and do not find any teaching of presenting a list of plural data items which the user selects from. The examiner maintains that Wang at column 17 teaches a list of certificates. (Answer at page 17.) We cannot agree with the examiner. While we do find a teaching that the mobile unit can be backwards compatible and transmit transaction data back to the server at column 17, lines 20-32, we do not find any specific teaching of the use of a list of certificates. While we may speculate how the backwards compatibility would operate, we can neither find that a list of certificates is taught by Wang nor that it would have been an inherent feature in the prior art methodology. Therefore, we find that the examiner has not established a ***prima facie*** case of anticipation of independent claims 23, 30, and 31 and their dependent claims 24, 25, 28 and 29. While appellants have not grouped claims 26 and 27 into this or any other grouping, we will address these two claims with respect to this issue since they depend on independent claim 23.

While the examiner rejected dependent claim 27 over the combination of Wang and Donoho, the examiner has not identified how the teachings of Donoho remedy the deficiency noted above with respect to a lack of a teaching or suggestion of the use of a list of certificates. Therefore, we likewise cannot sustain the rejection of dependent claims 26 and 27 since the examiner has not established a ***prima facie*** case of obviousness.

ISSUE C

Appellants argue that independent claim 1 requires “passing the user authentication message from the mobile station to the computer over the bi-directional transmission link.” (Brief at page 14.) Appellants argue that Wang teaches away from the transmission of a PIN since the identification data remains secure in the PEAD at all times. (Brief at page 14.) While a majority of the teachings of Wang are directed to keeping this information secure, Wang also teaches at column 17, lines 21-28, that if a requesting device is not enabled with a transaction approval device the user may still be required to proceed with the transaction by authenticating, approving and/or supplying the requested data conventionally using any of the aforementioned data entry techniques and that the data would be transmitted back to the server to complete the transaction. At columns 1 and 2, Wang teaches the conventional use of identification data to authenticate oneself and explains an example of the use of a PIN in with an ATM transaction. Therefore, we find that Wang teaches the use of a PIN which teaches the “passing the user authentication message from the mobile station to the computer over the bi-directional transmission link.” Since we do not find either of appellants’ arguments with respect to issues A or C to be persuasive, we will sustain the rejection of independent claim 1 and claims 3-7, 9-16, and 18-20 which are grouped therewith.

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CONCLUSION


To summarize, the decision of the examiner to reject claims 23-25 and 28-31 under 35 U.S.C. § 102 is reversed, the decision of the examiner to reject claims 26, and 27 under 35 U.S.C. § 103 is reversed, and the decision of the examiner to reject claims 1, 3-7, 9-16, and 18-22 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


JOSEPH L. DIXON
Administrative Patent Judge

~~LANCE LEONARD BARRY~~
~~Administrative Patent Judge~~


ALLEN R. MACDONALD
Administrative Patent Judge

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